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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 09/981,877
Filing Date: October 18, 2001
Appellant(s): MARTINEZ ET AL.

Robert C. Rolnik (Reg. No.: 37,995)
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed 4-13-2009 appealing from the Office action mailed 11-25-2008.

(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

The following are the related appeals, interferences, and judicial proceedings known to the examiner which may be related to, directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal:

Appeal 2007-3276

(3) Status of Claims

The statement of the status of claims contained in the brief is correct.

(4) Status of Amendments After Final

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct.

(6) Grounds of Rejection to be Reviewed on Appeal

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct.

(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) Evidence Relied Upon

Microsoft, Microsoft Word 2000, 1999, Microsoft Corporation, as represented by attached figures 1-10

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

2. Claim 17 is rejected under 35 U.S.C. 102(a) as being anticipated by Microsoft, "Microsoft Word," hereinafter MSword.

3. With regard to claim 17, which teaches a method of displaying a clipboard comprising: receiving a paste command, MSword teaches, in figure 2 and 4, receiving a paste command through an icon on the clipboard, through the Edit menu, or through typing CONTROL+V on the keypad.

With regard to claim 17, which further teaches determining whether a plurality of objects are stored within the clipboard in response to the paste command, MSword teaches, in figures 2, 4, and 10, that in order for an item to be pasted it must be copied/cut from a document first, and upon a selection of more than one item to be copied/cut the clipboard is automatically displayed on the screen.

With regard to claim 17, further teaching displaying a clipboard adjacent a display position indicator, if it is determined a plurality of objects are within the clipboard, MSword teaches, in figures 1 and 2 that upon selection of more than one item to be stored on a clipboard the clipboard is displayed to provide the user with a selectable array of pasteable items.

With regard to claim 17, which further teaches removing the clipboard in response to moving the position indicator so that the position indicator is not adjacent to the clipboard, MSword teaches, in figures 6 and 7, hiding the clipboard upon positioning the indicator off of the clipboard and onto another region of the display space. This can further be evidenced by page 11 of the 2/09/09 Affidavit (page 32 of the Appeal Brief), where Anthony Champion states that "I can make the clipboard disappear by first placing the cursor over 'Items' menu (See Fig. G), and then moving to the left." "Once the mouse leaves the 'Items' menu, the clipboard disappears, as shown in Figure J." (see the third and fourth statements on page 11 and figures G, I, and J).

Claim Rejections - 35 USC § 103

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

10. Claims 1-3 and 9-11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Microsoft, "Microsoft Word," hereinafter MSword in view of Foster et al., Patent Number: 5,404,442, hereinafter Foster.

11. With regard to claim 1, which teaches a method of previewing a graphical image corresponding to an icon in a clipboard (see MS figure 2), comprising: receiving a icon preview instruction from a user, MSword teaches, in MS figure 2, the user accessing a preview of a clipboard item through a mouse over event.

With regard to claim 1, further teaching displaying the graphical image associated with the icon in response to the icon preview instruction, MSword teaches, in MS figure 2, the system displaying a preview (text representative of text copied to the clipboard element) of a clipboard item in response to a mouse over event.

MSword, however, doesn't specifically teach displaying a **graphical image** associated with the icon in response to the icon preview instruction (see board decision of 1-4-2008).

Foster teaches a process for copying items to a display space (clipboard) for later use in insertion into a document (see column 7, line 56 through column 8, line 15 and in figures 4e-4f), similar to that of MSword, but further teaches, in the second process, that upon a user selection of an item from the group of clipped items the user is provided with a visual depiction of the actual object the pointer is positioned over (see column 9, lines 44-65 and figure 5c) where elements available for clip based storage include both text elements and graphic elements (see column 7, line 56 through column 8, line 15 and in figures 4e-4f). Foster further teaches the ability for clipboard icons to

indicate the actual content of the clipboard object, showing a miniature version of the actual graphical object (see column 12, lines 18-23).

It would have been obvious to one of ordinary skill in the art, having the teachings of MSword and Foster before them at the time the invention was made to modify text based representation of the contents of a clipped item of MSword to include a graphical representation of the actual object being dragged. One would have been motivated to make such a combination as this allows for multiple types of media to be previewed, thereby enhancing the user perception of multiple types of stored clipboard data, making them aware of exactly what is to be pasted by seeing the actual graphical image of what is to be pasted. As stated in Foster the user can "see the object and therefore more accurately position the object for pasting into the application program" (see Foster column 9, lines 63-65).

12. With regard to claims 2 and 10, which teach receiving an icon preview instruction comprises determining whether a display position indicator is positioned over the icon displayed in the clipboard for a predetermined time period, MSword teaches, in MS figures 2 and 3, the preview being delayed by some predetermined time.

13. With regard to claims 3 and 11, which teach displaying the graphical image comprises displaying a reduced image of the graphical image, MSword teaches, in MS figures 2 and 9, upon positioning an indicator over an element in the clipboard, displaying a subset of the text copied to the clipboard. Foster further teaches, initiating selection of an item from the group of clipped items causing the user to be provided with a visual depiction of the actual object the pointer is positioned over (see column 9, lines

44-65 and figure 5c) where elements available for clip based storage include both text elements and graphic elements (see column 7, line 56 through column 8, line 15 and in figures 4e-4f). Foster further teaches the ability for clipboard icons to indicate the actual content of the clipboard object, showing a miniature version of the actual graphical object (see column 12, lines 18-23).

14. With regard to claim 9, which teaches a computer usable medium including a program for previewing a graphical image corresponding to an icon in a clipboard (see MS figure 2), comprising: computer readable code for receiving a icon preview instruction from a user, MSword teaches, in MS figure 2, the user accessing a preview of a clipboard item through a mouse over event. With regard to claim 9, further teaching computer readable code for displaying the graphical image associated with the icon in response to the icon preview instruction, MSword teaches, in MS figure 2, the system displaying a textual preview of a clipboard item in response to a mouse over event.

MSword, however, doesn't specifically teach displaying a **graphical image** associated with the icon in response to the icon preview instruction (see board decision of 1-4-2008).

Foster teaches a process for copying items to a display space (clipboard) for later use in insertion into a document (see column 7, line 56 through column 8, line 15 and in figures 4e-4f), similar to that of MSword, but further teaches, in the second process, that upon a user selection of an item from the group of clipped items the user is provided with a visual depiction of the actual object the pointer is positioned over (see column 9, lines 44-65 and figure 5c) where elements available for clip based storage

include both text elements and graphic elements (see column 7, line 56 through column 8, line 15 and in figures 4e-4f). Foster further teaches the ability for clipboard icons to indicate the actual content of the clipboard object, showing a miniature version of the actual graphical object (see column 12, lines 18-23). It would have been obvious to one of ordinary skill in the art, having the teachings of MSword and Foster before him at the time the invention was made to modify text based representation of the contents of a clipped item of MSword to include a graphical representation of the actual object being dragged. One would have been motivated to make such a combination as this allows for multiple types of media to be previewed, thereby enhancing the user perception of multiple types of stored clipboard data, making them aware of exactly what is to be pasted by seeing the actual graphical image of what is to be pasted. As stated in Foster the user can "see the object and therefore more accurately position the object for pasting into the application program" (see Foster column 9, lines 63-65).

(10) Response to Argument

As an initial note the 1-26-2009 Affidavit was considered and placed on the record on 2-9-2009.

Claim 17:

With respect to the arguments directed at the independent 17 the Appellant's arguments are focused on the limitations regarding the removal of the clipboard in

response to movement not adjacent to the clipboard. More specifically, as stated from Claim 17, the limitation argued is:

“

*removing the clipboard from a display in response to
movement of the display position indicator not adjacent to the clipboard.*

”

Since the interpretation of the limitation is the basis for the arguments, the Examiner's interpretation is now given. The claim, as interpreted by the examiner, pertains to a system in which a clipboard is removed from display responsive to a cursor movement that is not adjacent to the clipboard. As stated in the eighth paragraph of MPEP 2101[R2].II.C.,

*“Office personnel are to give claims their broadest reasonable
interpretation in light of the supporting disclosure. In re Morris, 127 F.3d
1048, 1054-55, 44 USPQ2d 1023,1027-28 (Fed. Cir. 1997).”*

Based on the interpretation of the claim limitations being argued, the Examiner will now explain how the teachings of the MSword references are within the scope of these limitations.

With regard to claim 17, which teaches a method of displaying a clipboard comprising: receiving a paste command, MSword teaches, in figure 2 and 4,

receiving a paste command through an icon on the clipboard, through the Edit menu, or through typing CONTROL+V on the keypad. With regard to claim 17, which further teaches determining whether a plurality of objects are stored within the clipboard in response to the paste command, MSword teaches, in figures 2, 4, and 10, that in order for an item to be pasted it must be copied/cut from a document first, and upon a selection of more than one item to be copied/cut the clipboard is automatically displayed on the screen. With regard to claim 17, further teaching displaying a clipboard adjacent a display position indicator, if it is determined a plurality of objects are within the clipboard, MSword teaches, in figures 1 and 2 that upon selection of more than one item to be stored on a clipboard the clipboard is displayed to provide the user with a selectable array of pasteable items. With regard to claim 17, which further teaches removing the clipboard in response to moving the position indicator so that the position indicator is not adjacent to the clipboard, MSword teaches, in figures 6 and 7, hiding the clipboard upon positioning the indicator off of the clipboard and onto another region of the display space. This can further be evidenced by page 11 of the 2/09/09 Affidavit (page 32 of the Appeal Brief), where Anthony Champion states that "I can make the clipboard disappear by first placing the cursor over 'Items' menu (See Fig. G), and then moving to the left." "Once the mouse leaves the 'Items' menu, the clipboard disappears, as shown in Figure J." (see the third and fourth statements on page 11 and figures G, I, and J).

The examiner will now address the individual arguments and statements made by Appellant.

As an initial note during tests conducted during a 12-5-2008 interview between Robert C. Rolnik, Holly Karr, and Dennis Bonshock it was agreed to by the applicants representative that through specific movements of a cursor off of the clipboard the clipboard was removed from display. The Applicants argue via the attached Affidavit that there are ways of exiting the cursor from the clipboard that do not result in the clipboard being removed from the display. The Examiner does not believe this is relevant give that there are ways of exiting the clipboard in which the clipboard is removed from the display responsive to the movement, the Applicants seem to admit to this repeatedly through out the appeal (see page 11 first paragraph, page 12 first, third, and fourth paragraphs). Given the claim language, for the claim to be satisfied it only requires a movement not adjacent to the clipboard to cause removal.

From page 10 of the Appeal Brief, from the first paragraph, the Appellant argues that it requires a click of a mouse to remove the clipboard from the display.

The Examiner respectfully contends that the best evidence that MSWord does not require a mouse click to remove the clipboard from the display, but only requires movement of the mouse not adjacent to the clipboard, is from page 11

and of the Affidavit (page 32 of the Appeal Brief), where Anthony Champion shows through operation of MSword that:

"I can make the clipboard disappear by first placing the cursor over 'Items' menu (See Fig. G), and then moving to the left."

"Once the mouse leaves the 'Items' menu, the clipboard disappears, as shown in Figure J."

(see the third and fourth statements on page 11 and figures G, I, and J)

From page 11 of the Appeal Brief, from the second paragraph, the Appellant argues that coincidental present of the cursor does not express public use of a cursor's changed location causing removal in the manner claimed.

The Examiner respectfully contends that that this feature was present in the art as a known operation of the published software, where its operation is further testified to in the previous paragraph in the appeal brief (page 11, first paragraph), stating "When the cursor 103 penetrates any part of the boundary 105, MSword behaves by removing the clipboard 107. Accordingly, it is apparent that the cause of the removal is the event of the cursor 103 leaving the "Items" menu 101." This clearly meets the claim language of "movement... not adjacent to the clipboard", as the cursor is over the "Items" menu (not over the clipboard) and moves to the area immediately to the left of the "Items" menu (not over the clipboard). Therefore there was a movement, not adjacent to the clipboard, that caused the removal of the clipboard.

From page 12 of the Appeal Brief, from the fourth paragraph, the Appellant argues that "In short, MSWord teaches to remove the clipboard when the cursor moves from Items menu 101 to the menu item "Paste All". At that time, the cursor was already not adjacent to the clipboard."

The Examiner respectfully contends that movement of the cursor from the "Items" menu (admitted above to be "not adjacent to the clipboard") to the "Paste All" which is not adjacent to the clipboard provides the cause for removal specified in the claims.

Applicants try to insinuate that the claims teach removal of the clipboard at the instant the cursor leaves the bounds of the clipboard, which is clearly not the case given the broader language of the claims, allowing for any movement, so long as is not adjacent to the clipboard, to cover the limitation.

Claims 1-3 and 9-11:

With respect to the arguments directed at the independent claims including Claims 1 and 9 the Appellant's arguments are focused on the limitations regarding the existence of graphical image preview. More specifically, as stated from representative Claim 1, the limitation argued is:

"

displaying the graphical image associated with the icon in response to the icon preview instruction.

”

Since the interpretation of the limitation is the basis for the arguments, the Examiner's interpretation is now given. The claim, as interpreted by the examiner, pertains to a system in which a graphical image is displayed responsive to a graphical preview being requested. As stated in the eighth paragraph of MPEP 2101[R2].II.C.,

“Office personnel are to give claims their broadest reasonable interpretation in light of the supporting disclosure. In re Morris, 127 F.3d 1048, 1054-55, 44 USPQ2d 1023,1027-28 (Fed. Cir. 1997).”

Based on the interpretation of the claim limitations being argued, the Examiner will now explain how the teachings of the MSword and Foster references are within the scope of these limitations.

With regard to the claims teaching previewing a graphical image corresponding to an icon in a clipboard (see MS figure 2), comprising: receiving a icon preview instruction from a user, MSword teaches, in MS figure 2, the user accessing a preview of a clipboard item through a mouse over event. With regard to the claims further teaching displaying the graphical image associated with the icon in response to the icon preview instruction, MSword teaches, in MS figure 2, the system displaying a preview (text representative of text copied to the clipboard element) of a clipboard item in response to a mouse over event.

MSword, however, doesn't specifically teach displaying a **graphical image** associated with the icon in response to the icon preview instruction (see board decision of 1-4-2008).

Foster teaches a process for copying items to a display space (clipboard) for later use in insertion into a document (see column 7, line 56 through column 8, line 15 and in figures 4e-4f), similar to that of MSword, but further teaches, in the second process, that upon a user selection of an item from the group of clipped items the user is provided with a visual depiction of the actual object the pointer is positioned over (see column 9, lines 44-65 and figure 5c) where elements available for clip based storage include both text elements and graphic elements (see column 7, line 56 through column 8, line 15 and in figures 4e-4f). Foster further teaches the ability for clipboard icons to indicate the actual content of the clipboard object, showing a miniature version of the actual graphical object (see column 12, lines 18-23).

It would have been obvious to one of ordinary skill in the art, having the teachings of MSword and Foster before them at the time the invention was made to modify text based representation of the contents of a clipped item of MSword to include a graphical representation of the actual object being dragged. One would have been motivated to make such a combination as this allows for multiple types of media to be previewed, thereby enhancing the user perception of multiple types of stored clipboard data, making them aware of exactly what is to be pasted by seeing the actual graphical image of what is to be pasted. As stated in Foster the user can "see the object and

therefore more accurately position the object for pasting into the application program" (see Foster column 9, lines 63-65).

The examiner will now address the individual arguments and statements made by Appellant.

From page 13 of the Appeal Brief, from the fourth paragraph, the Appellant argues the obviousness to combine.

In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, it would have been obvious to one of ordinary skill in the art, having the teachings of MSword and Foster before them at the time the invention was made to modify text based representation of the contents of a clipped item of MSword to include a graphical representation of the actual object being dragged. One would have been motivated to make such a combination as this allows for multiple types of media to be previewed, thereby enhancing the user perception of multiple types of stored clipboard data, making them aware of exactly what is to be pasted by seeing the actual graphical image

of what is to be pasted. As stated in Foster the user can "see the object and therefore more accurately position the object for pasting into the application program" (see Foster column 9, lines 63-65).

From page 15 of the Appeal Brief, from the second paragraph, the Appellant argues that the board has affirmed the applicant by interpreting that a teaching of text does not teach a claim 1 recited, "graphical image".

The Examiner respectfully contends that the board decision was considered and respected by the Examiner and that is why the Foster referenced had been applied when reopening. Foster teaches a process for copying items to a display space (clipboard) for later use in insertion into a document (see column 7, line 56 through column 8, line 15 and in figures 4e-4f), similar to that of MSword, but further teaches, in the second process, that upon a user selection of an item from the group of clipped items the user is provided with a visual depiction of the actual object the pointer is positioned over (see column 9, lines 44-65 and figure 5c) where elements available for clip based storage include both text elements and graphic elements (see column 7, line 56 through column 8, line 15 and in figures 4e-4f). Foster further teaches the ability for clipboard icons to indicate the actual content of the clipboard object, showing a miniature version of the actual graphical object (see column 12, lines 18-23).

From page 15 of the Appeal Brief, from the third paragraph, the Appellant argues that there would be no motivation to combine as MSWord already shows a buttons contents in a little yellow box.

The Examiner respectfully contends that the addition of previews of graphical content provides the user with a better indication of the actual content of the representative icon. The added features of Foster are not redundant as Foster adds support for viewing miniature version of actual content not just a representative preview image. Foster further teaches the ability for clipboard icons to indicate the actual content of the clipboard object, showing a miniature version of the actual graphical object (see column 12, lines 18-23). (see motivation supra)

(11) Related Proceeding(s) Appendix

Copies of the court or Board decision(s) identified in the Related Appeals and Interferences section of this examiner's answer are provided herein.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

Conferees:

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